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FACSIMILE TRANSMISSION**CONFIDENTIAL****DATE:** July 16, 2009**CLIENT-MATTER NUMBER:** 18602-06514**To:**

NAME:	FAX No.:	PHONE No.:
Examiner Jason D. Mitchell USPTO	571-273-3728	571-272-3728

FROM: Sabra-Anne Truesdale**PHONE:** (650) 335-7187**RE:** USSN 09/990,887**NUMBER OF PAGES WITH COVER PAGE:** 4**MESSAGE:**

Please see attached.

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Brief Description of Arguments to be Presented

re: Application No. 09/990,887 (Atty Docket 18602-06514)

The present application is a reissue of U.S. Patent 5,991,542 ("the '542 Patent"). Claims 21-38 were rejected under 35 USC 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the '542 Patent (Detailed Action, page 2). Applicant traverses.

Recapture analysis is performed according to a three-step process (MPEP 1412.02(I)). The first step is to determine whether, and in what respect, the reissue claims are broader in scope than the original patent claims (MPEP 1412.02(I)(1)). Here, Examiner cited three broadening aspects:

- omission of "means for creating a disk image" (Detailed Action, pp. 2-3)
- omission of "mounting" (Detailed Action, p. 3)
- omission of "is a virtual representation of said physical storage volume such that it includes volume format information" (Detailed Action, p. 3)

Assume, *arguendo*, that this is correct.

The second step is to determine whether the broader aspects of the reissue claims relate to subject matter surrendered in the original prosecution (MPEP 1412.02(I)(2)). Each broadening aspect is reviewed for this determination (MPEP 1412.02(I)(B)). The determination involves two sub-steps (MPEP 1412.02(I)(B)). The first sub-step is to determine whether applicant surrendered any subject matter in the prosecution of the original application that became the patent to be reissued (MPEP 1412.02(I)(B)(1)(A)).

If an original patent claim limitation now being omitted or broadened in the present reissue application was originally relied upon by applicant in the original application to make the

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claims allowable over the art, the omitted limitation relates to subject matter previously surrendered by applicant (MPEP 1412.02(I)(B)(1)(A)). To determine whether such reliance occurred, the examiner must review the prosecution history of the original application file (of the patent to be reissued) for recapture.

Here, Examiner cited one document (the Amendment that was filed July 17, 1998) as proof that surrender occurred (Detailed Action, p. 3). However, the entire prosecution history should be reviewed. A different document (the Amendment that was filed March 1, 1999) proves that surrender did not occur.

The March 1999 Amendment argued that the Office Action mailed November 27, 1998, should not have been final because the new grounds of rejection, and the application of newly cited references, were not necessitated by the amendments presented in the July 1998 Amendment (March 1999 Amendment, pp. 3-4). Specifically, the March 1999 Amendment stated:

In the previous response, the Applicants did present a number of amendments, which were purely for clarification purposes. The amendments in no way added features to or deleted features from the claimed system. In other words, despite the amendments, the scope of the claimed invention remained essentially unchanged.

(p. 3). The Amendment continued on to explain why the claim amendments did not change the scope of the claims (pp. 3-4).

In determining whether “surrender” of subject matter has occurred, the proper inquiry is whether an objective observer viewing the prosecution history would conclude that the purpose of the patentee’s amendment or argument was to overcome prior art and secure the patent (Kim v. ConAgra Foods, Inc., 465 F.3d 1312, 1323 (Fed. Cir. 2006)). This is because the recapture

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rule is aimed at ensuring that the public can rely on a patentee's admission during prosecution of an original patent (*Id.*).

Here, an objective observer viewing the prosecution history (including both the July 1998 Amendment and the March 1999 Amendment) would not conclude that the purpose of the amendments and arguments was to overcome the prior art. Instead, the objective observer would see Applicant's statements (cited above) directly to the contrary and would understand that the amendments were for clarification purposes and did not change the scope of the claims. The observer would thus conclude that no surrender had occurred.

Therefore, no surrender occurred. Since Applicant did not surrender any subject matter in the prosecution of the original application, the analysis ends and there is no recapture (MPEP 1412.02(I)(B)(1)(A)).